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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/648,270	05/15/96	TOR	Y A-63463-1

EXAMINER

12M1/0520

FLEHR HOHBACH TEST
ALBRITTON AND HERBERT
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111

CRANE, L	PAPER NUMBER
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1211

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DATE MAILED: 05/20/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 01/27/97 (IDS), paper no. 5

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-10 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

IN 08/648,270

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

Art Unit 1211

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1200, Art Unit 1211.

5 No claims have been cancelled.

Claims 1-10 remain in the case.

10 Applicant is requested to note that Examiner has had difficulty in determining the proper division of the instant subject matter because of confusion concerning claim dependencies and related questions concerning proper antecedent basis. The following Restriction Requirement represents the simplest division Examiner could envision in view of the noted concerns.

Restriction to one of the following inventions is required under 35 U.S.C. §121:

15 I. Claims 1-3, drawn to a method for making acetylenyl derivatives of 3, 8-dibromo phenanthroline, classified in Class 546, subclass 088.000.

20 II. Claim 6, drawn to polymers of a monomeric unit containing a metal complex and two acetylenic units, classified in Class 526, subclass 241.000.

III. Claim 7, drawn to a tris(bisacetylenyl phenanthroline metal complex), classified in Class 546, subclass 088.000.

IV. Claim 8, drawn to a nucleoside labeled with a acetylenyl phenanthroline attached through the heterocyclic base, classified in

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Class 536, subclass 028.540+ (based on Structure 9 at p. 12 of the disclosure).

5 V. Claims **9-10**, drawn to a nucleotide and a nucleoside phosphoramidite (See Structures 10-11 at p. 12 of the disclosure), respectively, each of which is labeled with a acetylenyl phenanthroline attached through the heterocyclic base, classified in Class 536, subclass 026.600.

10 Claims **4 and 5** appear to link inventions **IV and V** and will be examined with the elected invention to the extent to which they apply.

The inventions are distinct, each from the other because of the following reasons:

15 Inventions **I and II** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have different functions** as the first invention is directed to a method of making an acetylenated phenanthroline and the second invention is directed to a
20 polymer made from a monomer containing two linked acetylenyl moieties and a phenanthroline/metal complex.

25 Inventions **II and III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have different functions** the first invention being directed to a method of

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making a diacetylenated phenanthroline and the second invention being directed to a compound which contains three diacetylenated phenanthroline/metal complex moieties.

5 Inventions **I** and **IV** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have different functions** the first invention being directed to a method of making
10 an acetylenated phenanthroline and the second invention being directed to a compound containing a nucleoside linked to a phenanthroline through an acetylenyl moiety.

15 Inventions **I** and **V** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have different functions** the first invention being directed to a method of making
20 an acetylenated phenanthroline and the second invention being directed to a compound containing a nucleotide, or a nucleoside phosphoramidite, linked to a phenanthroline through an acetylenyl moiety.

25 Inventions **II** and **III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have different functions** the first invention being directed to a polymeric

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compound containing a pair of acetylenyl moieties linked to a phenanthroline/metal complex and the second invention being directed to a tris(bisacetylenyl phenanthroline metal complex).

5 Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have**
10 **different functions** the first invention being directed to a polymeric compound containing a pair of acetylenyl moieties linked to a phenanthroline/metal complex and the second invention being directed to nucleoside linked to a phenanthroline moiety through an acetylenyl moiety.

15 Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have different**
20 **functions** the first invention being directed to a polymeric compound containing a pair of acetylenyl moieties linked to a phenanthroline/metal complex and the second invention being directed to nucleotide, or a nucleoside phosphoramidite, linked with a acetylenyl phenanthroline through the heterocyclic base.

25 Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have**

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different functions the first invention being directed to a tris(bisacetylenyl phenanthroline metal complex) and the second invention being directed to a nucleoside labeled with a acetylenyl phenanthroline attached through the heterocyclic base.

- 5 Inventions **III** and **V** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have**
- 10 **different functions** the first invention being directed to a tris(bisacetylenyl phenanthroline metal complex) and the second invention being directed to a nucleotide, or a nucleoside phosphoramidite, labeled with a acetylenyl phenanthroline attached through the heterocyclic base. .
- 15 Inventions **IV** and **V** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions **have**
- 20 **different functions** the first invention being directed to a nucleoside labeled with a acetylenyl phenanthroline attached through the heterocyclic base and the second invention being directed to a nucleotide, or nucleoside phosphoramidite labeled with a acetylenyl phenanthroline attached through the heterocyclic base.
- 25 Because these inventions are distinct for the reasons given above and 1) have acquired a separate status in the art as shown by their divergent classification, 2) have acquired a separate status in the art because of their recognized divergent subject matter, and 3) the

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search required for each of Groups **II, IV, or V** are not required for either of Groups **I and III**, restriction for examination purposes as indicated is proper.

5 A telephone call was made to Mr. Richard F. Trecartin on April 31, 1997 to request an oral election to the above restriction requirement, but did not result in an election being made.

10 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(h).

15 Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. §1.143).

20 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to
25 consider the applicability of potential 35 U.S.C. §§102(f) or (g) prior art under 35 U.S.C. §103.

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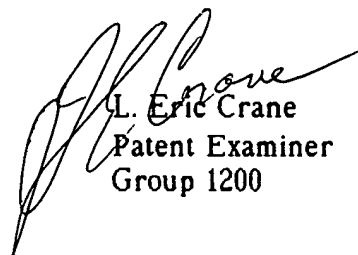
Papers related to this application may be submitted to Group 1200 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1200 are **(703) 308-4556 (for Official papers)** and **703-308-7923** (for Draft communications).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **703-308-4639** . The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kight III, can be reached at (703)-308-1235.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1200 receptionist whose telephone number is **703-308-1235** .

LECrane:lec
5/16/97


L. Eric Crane
Patent Examiner
Group 1200